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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,352	10/18/2000	Duane M. Pinault	55126USA3A.002	3971

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT                  PAPER NUMBER

1772

3

DATE MAILED: 03/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MF=3

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/691,352	PINAULT ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Patricia L. Nordmeyer	1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on \_\_\_\_\_.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-34 is/are pending in the application.

4a) Of the above claim(s) 20-25 and 32-34 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-19 and 26-31 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1</u> .	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1- 19 and 26 - 31, drawn to an integrated granule product, classified in class 428, subclass 141.
  - II. Claims 21 – 25 and 32 - 34, drawn to a method of making an integrated granule product, classified in class 156, subclass 60.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group II, claims 21 – 25 and 32 - 34 and Group I, claims 1 – 19 and 26 - 31 are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make a materially different product such as a retro-reflective article.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, different modes of operation, different functions, different effects and their divergent subject matter, restriction for examination purposes as indicated is proper.

Art Unit: 1772

4. During a telephone conversation with Brian Szymanski on January 30, 2002 a provisional election was made with traverse to prosecute the invention of an integrated granule product, claims 1 – 19 and 26 - 31. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21 – 25 and 32 – 34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8 and 9 contain the trademark/trade name HunterLab and scale coordinates L\*, a\* and b\*. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The

Art Unit: 1772

claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a spectrophotometer and color coordinates and, accordingly, the identification/description is indefinite.

8. Regarding claims 6, 13, and 18, the phrase "like" renders the claims indefinite because the claims include elements not actually disclosed (those encompassed by "like"), thereby rendering the scope of the claims unascertainable. See MPEP § 2173.05(d).

*Claim Rejections - 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1 – 7, 10, 12 - 16 and 26 – 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over George et al. (USPN 5,516,573) in view of Katsamberis (USPN 5,258,225).

George et al. discloses granules coated with a ceramic (Column 3, lines 8 – 12) dispersed in adhesive and asphalt (Column 9, lines 30 – 32) located on the surface of a shingle or roofing material (Figure 3, #63 and Column 46 – 47) where the shingle has a non-woven substrate saturated with asphalt (Column 9, lines 24 – 25). However, George et al. fails to disclose the

Art Unit: 1772

granules being attached to a polymeric film with cured adhesive, the adhesive being cured by ultraviolet radiation, thermal radiation, actinic radiation, ionizing radiation, moisture activation, photo activation or combinations thereof, the adhesive being flexible as indicated by tensile elongation of 25% or greater according to ASTM D-882.97, the adhesive selected from acrylated urethanes, multi-functional acrylate monomers, acrylated epoxies, acrylated polyesters, acrylated polyethers, urethanes, epoxies, acrylics, phenolics, cyanate esters, bismaleimides, and hot melts, the adhesive is an acrylated aliphatic urethane, and the film or cured adhesive containing toughening agents, pigments, adhesion promoters, dyes, filling agents, initiators, catalysts, antimicrobials, algaecides, ultraviolet stabilizers, ultraviolet absorbers, antioxidants or combinations thereof.

Katsamberis teaches an adhesive made from acrylated aliphatic urethane cured with ultraviolet radiation (Column 11, claims 1 and 3) and containing ultraviolet absorbers and photoinitiators (Column 8, lines 19 – 61) on a polycarbonate film (Column 9, lines 47 – 51) for the purpose of making an article with an abrasion resistant coating.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the cured adhesive made from acrylated aliphatic urethane with ultraviolet absorbers and photoinitiators on a film in George et al. in order to make an article with an abrasion resistant coating as taught by Katsamberis.

Regarding claims 2, 5, 14, and 15, since George et al. in view of Katsamberis discloses the same materials desired by the applicant, it is inherent that the product is pliable as determined by the flexibility test procedures according to ASTM D-228-00, the adhesive is flexible as indicated by a tensile elongation result of 25% or greater according to ASTM D-882.97 and the

Art Unit: 1772

roof shingle exhibits a tensile strength of greater than 50% over a shingle without the integrated granule product according to American Roofing Manufacturers Association Test Index No. 2,126.

Regarding the curing of the adhesive through the use of ultraviolet radiation, thermal radiation, actinic radiation, ionizing radiation, moisture activation, photo activation or combinations thereof in claim 4, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation of curing of the adhesive through the use of ultraviolet radiation, thermal radiation, actinic radiation, ionizing radiation, moisture activation, photo activation or combinations thereof is a method of production and therefore does not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Art Unit: 1772

11. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over George et al. (USPN 5,516,573) in view of Katsamberis (USPN 5,258,225) as applied to claims 1 – 7, 10, 12 - 16 and 26 – 29 above, and further in view of Weaver et al. (USPN 5,666,776).

George et al., as modified with Katsamberis, discloses the claimed invention above except for the cured adhesive not adversely affecting the aesthetic color of the ceramic coated granules as indicated by one unit or more change in any HunterLab color scale coordinates L\*, a\* or b\* and where the ceramic coated granules are white and the product exhibits an L\* value of 64 or greater according to HunterLab spectrophotometer test procedures.

Weaver et al. teaches a variety of colors including white (Column 4, lines 2 - 8) of ceramic coated granules on the surface of a shingle for the purpose of giving the shingle a desired color.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the colored ceramic granules in the modified George et al. in order to give the shingle a desired color as taught by Weaver et al.

Since the modified George et al. in view of Weaver et al. discloses the same materials in claims 8 and 9, including adhesive that does not affect the color of the ceramic, desired by the applicant, it is inherent that the aesthetic color of the ceramic granule is not adversely affected by the adhesive as indicated by one unit or more change in any HunterLab color scale coordinates L\*, a\* or b\* and the white ceramic granules and product exhibit an L\* value of 64 or greater according to HunterLab spectrophotometer test procedures.

Art Unit: 1772

12. Claims 11, 17 – 19, and 30 – 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over George et al. (USPN 5,516,573) in view of Katsamberis (USPN 5,258,225) as applied to claims 1 – 7, 10, 12 - 16 and 26 – 29, and further in view of Thomas et al. (USPN 6,291,054) and Kalkanoglu (USPN 5,206,068).

George et al., as modified with Katsamberis, discloses the cured adhesive film above except for the film including a primer layer, the granule product being suitable as an exposed surface layer for a floor construction where a plurality of ceramic coated granules are bonded to a supporting cured adhesive film and a polymeric sealant coat is applied over said plurality of ceramic coated granules, the article being a floor covering and the article comprising a polymeric sealant applied over the article.

Thomas et al. teaches a primer layer (Column 2, lines 37 – 41) with a coating completely covering the ceramics particles (Column 3, lines 47 – 62) on a substrate for the purpose of making an article that is abrasion resistant.

Kalkanoglu teaches ceramics coated granules in various colors (Column 4, lines 5 – 10) used on the surface of a roofing component or flooring (Column 3, line 56 to Column 4, line 2) for the purpose of providing UV and heat protection.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the primer layer and the coating covering the ceramic particles in flooring in the modified George et al. in order to make an abrasion resistant article that is heat and UV protected as taught by Thomas et al and Kalkanoglu.

Regarding claim 19, since the modified George et al. discloses the same materials desired by the applicant, it is inherent that the product's cured adhesive is flexible as indicated by a tensile elongation result of 25% or greater according to ASTM D-882.97.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (703) 306-5480. The examiner can normally be reached on Monday thru Friday from 8:15 a.m. until 4:45 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

*psln*  
pln  
March 7, 2002

*Harold Pyon*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
*1772*

*3/9/02*